

**Notice of Allowability**

Application No.

09/986,033

Examiner

Joseph T. Weitach

Applicant(s)

BUREAU ET AL.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to October 15, 2004.
2. ☒ The allowed claim(s) is/are 85-89,91,95,96,98,99,101,102 and 104-121.
3. ☒ The drawings filed on 11/7/2001 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

### **DETAILED ACTION**

This application is a continuation of 09/341,350, filed July 9, 1999, now abandoned, which is a 371 National stage filing of PCT/FR98/01400, filed June 30, 1998.

Applicants' amendments filed October 15, 2004, has been received and entered. The specification has been amended. Claims 1-84, 90, 92-94, 97, 100, 103 have been canceled. Claim 121 has been added. Claims 85, 98, and 120 have been amended. Claims 85-89, 91, 95, 96, 98, 99, 101, 102, 104-121 are pending and currently under examination.

### ***Election/Restriction***

As noted previously, Applicant's election with traverse of Group IV, in Paper No. 12 was acknowledged. The restriction requirement was withdrawn because Examiner agreed that it would not constitute an undue burden to examine all the pending claims in light of the inventive concept of the claimed invention. Newly added claim 121 is drawn to the elected invention.

### ***Priority***

Initially, the deletion of the amendment to the specification filed March 23, 2004, reciting 'are incorporated by reference herein' has obviated the objection made under 35 U.S.C. 132 regarding the introduction of new matter into the disclosure.

As discussed and agreed upon in the previous interview, the application has been amended to recite benefit to US provisional application 60/067,488, filed December 1, 1997, and

Art Unit: 1632

French application 97/08233 filed June 30, 1997. Since the declaration provided the correct claim for priority and this was recognized in the bibliographic data sheet of the PTO, the priority claim made in the first line of the specification has been accepted.

### ***Reasons for Allowance***

The following is an examiner's statement of reasons for allowance:

The amendments to the claims has differentiated the claimed invention from that disclosed in the prior art of record. Specifically, the use of electroporation for the transfer of polynucleotides to a cell in culture and in vivo were known in the prior art as evidenced by the teachings of Dev *et al.* (WO 96/39226 and 5,993,434). However, the prior art does not teach to use electrical stimulation that lasted 10 milliseconds or longer. The present specification details the use of low voltage applied for longer periods of time for the transfer of a polynucleotide to a muscle cell. Moreover, the specification provides evidence that these condition unexpectedly provided greater transfer and consequent expression of the transgene delivered.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

Art Unit: 1632

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (703) 308-2141.

Joseph T. Voitach

JOSEPH T. VOITACH  
PATENT EXAMINER  
*Joe Voitach*  
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